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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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1771-1023 10/05/98 MAY

D 1020-0501

EXAMINER

1M82/1007

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ART UNIT

PAPER NUMBER

1771

9

DATE MAILED:

10/07/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

Commissioner of Patents and Trad marks

# Office Action Summary

Application No.  
**09/166,625**

Applicant(s)

**May**

Examiner  
**Cheryl Juska**

Group Art Unit  
**1771**



☒ Responsive to communication(s) filed on Aug 2, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-17 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-17 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1771

## **DETAILED ACTION**

### ***Response to Amendment***

1. Amendment A, submitted as Paper No. 7 on August 2, 1999, has been entered. Claims 4-6, 9, 12, 13, and 17 have been amended as requested.
2. The amendments to the claims are sufficient to withdraw all the standing 35 USC 112, 2nd rejections, as set forth in section 7 of the last Office Action.

### ***Specification***

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the limitation that the "thickness is less than 10.0 mils" is not supported by the specification. Said rejection is maintained from the last Office Action. Said objection may be overcome by amending the specification to include said limitation. (It is noted that the 35 USC 112, 1st rejection, with regard to the "thickness is less than 10.0 mils," was erroneous. Hence, said rejection is hereby withdrawn.)

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 1771

5. Claims 1-17 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for “a liquid impervious and/or solvent resistant plastic material” (page 6, lines 8-10), does not reasonably provide enablement for “a plastic material” as recited in independent claims 1 and 10. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. Said rejection is maintained from the last Office Action, section 4, despite Applicant’s traversal.

As was noted in the last Office Action, the term “plastic material” includes polymeric fabric or film material, which may or may not be impervious to liquids. Hence, the claims are broader in scope than the disclosure of the invention. Claims *must* be limited to the disclosure of the invention. The specification does not define ‘plastic material’ to mean ‘liquid impervious.’ Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

6. Claims 9 and 17 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for “a layer of adhesive material...that facilitates the temporary attachment of bottom layer 14 to surface 11” (page 6, lines 16-18), does not reasonably provide enablement for “an adhesive material” as recited in claims 9 and 17. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Art Unit: 1771

As was noted in the last Office Action, the term "adhesive material" includes adhesives which are permanent, which is outside of the scope of Applicant's disclosure. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

***Claim Rejections - 35 USC § 103***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,266,390 issued to Garland alone, or in view of US Patent 5,368,912 issued to Reaves.

Said rejection is maintained from the last Office Action, sections 9-12, despite Applicant's traversal. Applicant arguments are well taken, but it appears that the Examiner's position was not clearly conveyed in the last Office Action. Specifically, it is argued that Garland teaches the importance of the nonwoven to be absorbent. Applicant is hereby given Official Notice that cotton and rayon are known in the art for their absorbent properties. Hence, it would have been obvious to one skilled in the art to substitute a known absorbent fiber, such as cotton or rayon, for the polypropylene of the Garland invention. Alternatively, Reaves teaches the equivalency of polypropylene and cotton fibers in a protective cover laminate (col. 2, lines 55-65). Therefore, it would have been obvious to one skilled in the art to substitute cotton fibers for the polypropylene fibers of the Garland invention. In either case, motivation to substitute cotton or rayon for the

Art Unit: 1771

polypropylene would be to improve the hand and the absorbency of the dropcloth of Garland.

Therefore, said claims are rejected over the cited prior art.

***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is (703) 305-4472. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached at (703) 308-2414. Fax numbers for this Group are (703) 305-3601 and (703) 305-7718.

cj

October 4, 1999

Elizabeth M. Cole  
Elizabeth M. Cole  
Primary Examiner  
Art Unit 1771